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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,712	02/09/2004	Connie C. Liu	146712011100	3832
50268	7590	09/12/2006		
SEAGATE TECHNOLOGY c/o MOFO NOVA 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102				
EXAMINER RICKMAN, HOLLY C				
ART UNIT			PAPER NUMBER	
1773				

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/775,712

Applicant(s)

LIU ET AL.

Examiner

Holly Rickman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16, 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Examiner's Comments***

1. The response after final filed 5/9/06 has been fully considered and was found to be persuasive with regard to the rejection of the claims as being obvious over Chen. This grounds of rejection has been withdrawn.

However, other prior art has been found and applied under 35 USC 102/103, below.

*Thus, the finality of the Office action mailed 1/9/06 has been withdrawn.*

An administrative error led to the delay in responding to Applicant's after final response filed 5/9/06. The examiner sincerely apologizes for this error. Applicant's are invited to contact the examiner by telephone after reviewing this Office action to discuss the outstanding rejections and expedite prosecution.

### ***Claim Objections***

2. The objection to claim 17 under 37 CFR 1.75(c), is withdrawn in view of Applicant's cancellation of the claim.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation in claim 21 requiring that the "electrolessly deposited nickel layer comprises NiP comprising about 15 atomic percent to about 30 atomic percent Ni" is new matter. The specification discloses a sputtered layer formed from NiP containing 15-30 at% Ni but not an electrolessly plated NiP having the claimed Ni amount.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 16 and 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nanis (US 5405646).

Nanis disclose a magnetic recording medium having a non-magnetic substrate formed from Al, glass, or glass-ceramic, a sputtered Ni layer, an electrolessly deposited NiP layer and a

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magnetic recording layer thereon. The reference teaches that the sputtered Ni-containing layer provides a smooth surface for the deposition of the NiP thereby producing a smooth NiP surface thereby eliminating the need for polishing. See col. 5, lines 4-30; col. 7, lines 1-25. The reference does not explicitly disclose the surface roughness (Ra) of the top surface of the composite nickel coating taught therein.

It is the examiner's contention that the smooth NiP layer taught by Nanis inherently satisfies the claimed surface roughness limitation by virtue of the fact that the structure taught therein has the same structure as claimed and is formed by the same method as claimed and therefore, would be expected to exhibit the same properties as claimed.

It has been held that where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess characteristics of claimed products where the rejection is based on inherency under 35 USC §102 or on prima facie obviousness under 35 USC §103, jointly or alternatively. *In re Best, Bolton, and Shaw*, 195 USPQ 430. (CCPA 1977).

### ***Claim Rejections - 35 USC § 103***

8. The rejection of claims 16-21 under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US 5153044) is withdrawn in view of Applicant's arguments and amendments.

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***Response to Arguments***

9. Applicant's arguments filed 5/9/06 have been fully considered but they are moot in view of the new grounds of rejection.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chakrabarti et al. (US 5747135) and Nanis (US 6986956) are cited as art of interest.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Rickman whose telephone number is (571) 272-1514. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Holly Rickman  
Primary Examiner